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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,180	06/09/1999	TORU KIMURA	20-4546P	1992
2292	7590	01/07/2004		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER CHEN, SHIN LIN	
			ART UNIT 1632	PAPER NUMBER 36

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/284,180

**Applicant(s)**

KIMURA ET AL.

**Examiner**

Shin-Lin Chen

**Art Unit**

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34,48-50,58,59,62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34,48-50,58 and 59 is/are allowed.
- 6) ☒ Claim(s) 62 and 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' amendment filed 11-14-03 has been entered. Claims 35-47, 51-57, 60 and 61 have been canceled. Claims 48, 58 and 59 have been amended. Claims 62 and 63 have been added. Claims 34, 48-50, 58, 59, 62 and 63 are pending and under consideration.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 62 and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' amendment filed 11-14-03 necessitates this new ground of rejection.

The phrase "a nucleotide sequence comprising SEQ ID No. 10 and SEQ ID No. 5 operatively linked in the 5' to 3' direction" in claims 62 and 63 is considered new matter. Although the example 4 of the specification (page 54, 55) discloses that SEQ ID No. 10 encodes 111 amino acid residues and SEQ ID No. 5 encodes 587 amino acid residues and they are parts of the human semaphorin cDNA sequences, however, the specification fails to provide sufficient disclosure for a nucleotide sequence comprising SEQ ID No. 10 operatively linked to SEQ ID No. 5 in the 5' to 3' direction, for example, 5' SEQ ID No. 10-SEQ ID No. 5 3'. The rat semaphoring protein has 776 amino acid residues, and SEQ ID No. 10 and SEQ ID No. 5 only

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encode partial human semaphorin protein sequences. There is a gap of about 70 amino acid residues between the amino acid sequences encoded by SEQ ID No. 10 and SEQ ID No. 5 within the complete human semaphorin amino acid sequence in applicants' amendment filed 11-20-01 (see exhibits 10 and 11). There is no evidence of record that SEQ ID No. 10 and SEQ ID NO. 5 can be linked side by side to encode a functional protein having the activity of inhibiting neurite outgrowth from dorsal root ganglion cells or the activity of collapsing growth cone of retinal ganglion cells. Therefore, the phrase "a nucleotide sequence comprising SEQ ID No. 10 and SEQ ID No. 5 operatively linked in the 5' to 3' direction" in claims 62 and 63 is considered new matter. Thus, claims 62 and 63 are rejected under 35 U. S. C. 112 first paragraph.

### ***Conclusion***

Claims 62 and 63 are rejected. Claims 34, 48-50, 58 and 59 are in condition for allowance.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (703) 305-1678. Due to the move of USPTO to new site in Alexandria, Virginia, examiner's telephone number will be changed to (571) 272-0726 **after January 12, 2004**. The examiner can normally be reached on Monday to Friday from 9:30 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on (703) 305-4051. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'SL Chen', is located in the lower right quadrant of the page.

Shin-Lin Chen, Ph.D.